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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/066,513	04/24/1998	KIM A. REYNOLDS	21669USA	8912

7590 12/26/2002

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EXAMINER

NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

23

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/066,513

Applicant(s)

REYNOLDS ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-17 and 25-31 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims

1. Claims 1-23 and 25-31 are pending. Claims 18-23 are non-elected pursuant to the requirement stated in

Withdrawal of Finality

2. The finality of the Office Action mailed on 22 May 2001 (Paper No. 12) is hereby withdrawn in order to apply the new grounds of rejection set forth below.

Rejection Withdrawn

3. The 35 USC 103 rejection restated in section 3 of the 12 October advisory action (Paper No. 16) is hereby withdrawn in view of applicants' arguments in their brief on appeal of 15 October 2002 (Paper No. 22).

Allowable Subject Matter

4. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach or suggest the fluorine-containing intermediate layer claimed.

New Rejections

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The reference to the General Motors test recited in claim 28 is indefinite because the test parameters may be changed.

Please clarify the claims.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-10 and 12-17 and 25-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 7-8 of U.S. Patent No. 5,653,266 in view of Miller et al (US 4,987,274) and Reynolds et al (US 6,040,384).

Reynolds ('266) teaches two fluorine-containing layers bonded together in the two outer layers of a conduit (abstract) for motion transmitting members (col. 1, line 8).

Reynolds fails to teach an inorganic filler in the outermost of its layers.

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Miller teaches an insulating layer containing a fluoropolymer and a ceramic filler, which filler reduces the coefficient of thermal expansion of the layer (abstract). The examiner takes official notice that a ceramic filler is inorganic.

Reynolds ('384) teaches cable assemblies having inorganic fillers in PTFE layers for improved abrasion resistance (col. 2, lines 46-48). The examiner takes official notice that PTFE is a known fluoropolymer.

The references are analogous because they all deal with conduits containing fluoropolymers.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the fillers of Miller and Reynolds ('384) in the outermost layers of the conduits of Reynolds ('266) in order to produce conduits whose outermost layers have desirable C.T.E. and abrasion resistance properties.

The motivation to employ the fillers of Miller in the conduits of Reynolds ('266) is found in the Miller abstract, where the effect of the fillers on C.T.E. is taught.

The motivation to employ the fillers of Reynolds ('384) in the conduits of Reynolds ('266) is found at col. 2, lines 46-48, where abrasion resistance is taught.

In the absence of convincing objective evidence to the contrary, the use of the fillers of Miller and Reynolds ('384) in the outermost of the two fluoropolymer layers of Reynolds ('266) is deemed a matter of engineering choice, depending upon the properties desired in the conduit's outer layer.

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Respons to Arguments

9. Applicant's arguments with respect to claims 1-17 and 25-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication should be directed to the Examiner, Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/305-5436. The fax number for after final communications is 703/872-9310. The receptionist answers 703/308-0661.



S. M. Nolan
Patent Examiner
Technology Center 1700

SMN/smn
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December 23, 2002